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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 91174297 |
| Party | Plaintiff<br>BRANDSTORM INC.<br>BRANDSTORM INC.<br><br>, |
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| Date | 05/16/2007 |
| Attachments | 91174297.pdf ( 9 pages )(316769 bytes ) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of
Application for Serial No. 78857705
For the mark HIMALAYAN GOJI JUICE
Published in the Official Gazette on October 24, 2006

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| BRANDSTORM INCORPORATED<br><br>Opposer,<br><br>v.<br><br>FREELIFE INTERNATIONAL, LLC<br><br>Applicant. | ) | Opposition No. 91174297 |

REPLY BRIEF IN SUPPORT OF OPPOSER'S MOTION TO REOPEN TIME

BrandStorm Inc. ("Opposer"),
a California corporation
10853 Venice Boulevard, Suite 2
Los Angeles, California 90034

Pursuant to Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 509.01(b), Opposer BrandStorm, Inc. ("Opposer") requested that the Trademark Trial and Appeal Board ("Board") reopen time in Opposition No. 91174297. On 3 May 2007, Applicant Free life International, LLC ("Applicant") filed a responsive brief to Opposer's motion (the "Response"). Opposer files this brief in support of its request to file a reply to Applicant's motion to dismiss the opposition for lack of standing and failure to state a claim (the "Motion to Dismiss").

## I. RELEVANT FACTUAL BACKGROUND

On 10 April 2006, Applicant filed applications for trademarks with the Serial Nos. 78857705 (the "First Mark") and 78857664 (the "Second Mark"). On 25 April 2006, Applicant filed an application for a trademark with the Serial No. 78868737 (the "Third Mark"). Applicant filed an application for a trademark with the Serial No. 76652196 (the "Fourth Mark") on 16 December 2005. All of the marks that Applicant seeks to register are virtually identical and/or closely related; moreover, all of the marks fall into one of two classes.

| | SERIAL NO. | MARK | CLASS | FILED | OPPOSITION |
|---|---|---|---|---|---|
| First Mark | 78857705 | Freelife Himalayan Goji | IC032[1] | 10 Apr 06 | Pub. date: 24 Oct 06<br>Opp.: 24 Nov 06 |
| Second Mark | 78857664 | Himalayan Goji Juice (+ drawing) | IC032 | 10 Apr 06 | Pub. date: 28 Nov 06<br>Opp.: 26 Dec 06 |
| Third Mark | 78868737 | Himalayan Goji Juice (+ drawing) | IC005[2] | 25 Apr 06 | Pub. date: 28 Nov 06<br>Opp.: 26 Dec 06 |
| Fourth Mark | 76652196 | Freelife Himalayan Goji | IC005 | 25 Apr 06 | Pub. date: 10 Apr 07<br>Opp.: 17 April 07 |

The application at issue in this opposition is for the First Mark (the "Application"), which concerns the same trademark as the Fourth Mark but in different classes. Similarly, the Second and Third Marks cover the same trademarks in different classes. Because all four marks are either identical marks and/or closely related, the Board should reject all four applications for the same key reasons: they are merely descriptive or primarily geographically descriptive.

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[1] IC032 covers "fruit-based beverages that are also nutritionally fortified and sports drinks."

[2] IC005 covers "nutritionally fortified fruit-based beverages."

## II. LEGAL ARGUMENT

### A. THE BOARD SHOULD REOPEN TIME SO THAT OPPOSER MAY NOT ONLY ESTABLISH THAT IT HAS STANDING TO OPPOSE THE APPLICATION, BUT SO THAT IT MAY ESTABLISH THAT THE APPLICATION MUST BE REJECTED.

In its Response to the Motion to Reopen, Applicant does not (and cannot) argue that it will suffer prejudice or harm if the Motion to Reopen is granted. Instead, Applicant opposes the motion because it seeks to prevent Opposer from proving valid arguments against the registration of the Application. If the Board grants the Motion to Reopen, Opposer will not only show it has standing and its opposition states a claim upon which relief can be granted, but that the Board should reject the pending Application.

Pursuant to TBMP § 309.03(b), a party has standing when it believes it will be damaged by registration of a mark. A plaintiff must simply "allege facts sufficient to show a 'real interest' in the proceeding, and a 'reasonable basis for its belief of damage.'" TBMP § 309.03(b). TBMP § 309.03(b) lists examples of instances where a real interest in the proceeding and a reasonable belief of damage may be found, including a claim of likelihood of confusion that is not wholly without merit. TBMP § 309.03(b) further provides that when descriptiveness or genericness of the mark is in issue, plaintiff may plead (and later prove) its standing by alleging that it is engaged in the sale of the same or related products or services, as in this instance. Opposer and Applicant both sell products containing and/or relating to goji berries. Opposer also has a reasonable basis in fact of damage. Opposer can show not only that the opportunity for confusion exists, but that actual confusion has occurred. Specifically, Opposer's products have already been

mistakenly connected with and/or confused for Applicant's products. The challenges presented by the confusion are compounded and exacerbated because both Applicant and Opposer utilize the same or substantially similar channels of trade, and sell to the same class of purchasers.

In its Motion to Dismiss, Applicant argued that "[b]ecause Opposer has failed to plead any facts in the Notice indicating 'it would be damaged' by the registration of Applicant's mark *as required by statute* [Emphasis added], Opposer's Notice must be dismissed." Motion to Dismiss, p.2. Applicant not only ignores the facts regarding actual confusion, but misstates the applicable standard recited in the TBMP. As TBMP § 309.03(b) provides, there is no requirement that actual damage be pleaded or proved to establish standing or to prevail in an opposition proceeding. Opposer is thus not required to plead any actual damage.

Applicant seeks to employ procedural maneuvers to deny Opponent the opportunity to present to the Board the grounds for the denial of the application involved in this opposition (as well as the related opposition). As explained in Opposition No. 91174297, several grounds for opposition exist under TBMP § 309.03(c). In this case, the Board should reject the Application because, among other things, Applicant's mark, when used on or in connection with its goods or services, is merely descriptive and/or primarily geographically descriptive of them. 15 U.S.C. § 1052(e)(1); TBMP § 309.03(c). The Board should grant Opposer the opportunity to establish that the Application should be rejected.

B. THE MOTION TO REOPEN SHOULD BE GRANTED WHERE APPLICANT WILL SUFFER NO PREJUDICE, ANY DELAY WILL BE MINIMAL WITH NO IMPACT ON THE PROCEEDING, AND OPPOSER ACTED IN GOOD FAITH.

TBMP § 509.01(b) requires that, when determining whether to reopen a matter, all relevant circumstances be considered, including: (1) danger of prejudice to nonmovant; (2) length of delay and its potential impact on judicial proceedings; (3) reason for delay, including whether it was within the reasonable control of the movant; and (4) whether movant acted in good faith. In its Response, Applicant ignored the analysis of the first, second and fourth factors enumerated in TBMP § 509.01(b). Indeed, Applicant failed to include even a cursory citation to the rule. Applicant consciously omitted any discussion of three of the factors listed in TMBP § 509.01(b) from its Response because the resulting analysis requires that the motion to reopen be granted in this case.

Applicant will suffer no prejudice if the motion to reopen is granted. As defined in § 509.01(b), prejudice to the nonmovant means a limitation or restriction on the nonmovant's ability to litigate the case. Opposer's delay has resulted in no loss or unavailability of evidence for the Applicant. Applicant still has the same ability to challenge the opposition as if Opposer's reply had been filed earlier. Applicant does not, and cannot, claim that it will suffer any prejudice if the matter is reopened.

In this case, the length of the delay is minimal and its potential impact on judicial proceedings is nonexistent. The final rebuttal testimony period is not until 30 December 2007, more than seven months away. There is ample time for the parties to continue with

the opposition proceedings. Nor will the delay have any significant impact on discovery. The discovery period opened on 20 December 2006 and was set to close on 18 June 2007. If the Board reopens time, there will still be sufficient time to conduct discovery and stay within the time parameters allotted for the opposition. The nature of the Application and the opposition do not require extensive discovery. Again, Applicant does not, and cannot, argue that the length of delay is unreasonable, nor can it show that there would be any potential impact on the judicial proceedings.[3]

In its Response, Applicant disregards all other factors and focuses its entire brief on the unsupported argument that Opposer cannot demonstrate excusable neglect. Opposer established all facts necessary to establish the excusable neglect that resulted in a delay to the filing of a reply to Applicant's motion. Opposer has only acted in good faith throughout the proceeding, a fact that Applicant does not refute. Although Opposer admits that it delayed for one short month, Opposer will proceed henceforth with a vigorous opposition to the Application and continue to act in good faith.

The totality of all relevant circumstances shows that neither Applicant nor Opposer would suffer any prejudice by the time delay. Applicant should not be released from defending its mark on the merits due to a brief delay. As discussed above, a valid challenge to the registration exists. Neither party will be harmed if the Board permits Opposer the opportunity to establish standing and a claim upon which relief can be granted.

Applicant contends that a separate opposition between the same parties and concerning a very similar mark does not affect this opposition. Applicant is wrong. As

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[3] Opposer is, however, generally willing to stipulate to a reasonable extension of the relevant deadlines in this matter if Applicant so requests.

explained below, important notions of administrative efficiency and due process compel the conclusion that the separate oppositions be decided in a consistent and unified manner where: (a) they involve the same parties; (b) concern virtually identical and/or substantially related marks; and (c) involve the same issues of trademark law. Granting the motion to reopen time ensures that the Board may address uniformly challenges to closely-related applications to nearly identical trademarks.

## C. THE BOARD SHOULD REOPEN TIME TO RESOLVE EFFICIENTLY AND EQUITABLY FOUR CLOSELY RELATED APPLICATIONS TO NEARLY IDENTICAL TRADEMARKS.

The Board should exercise its discretion to reopen the proceeding to allow Opposer an opportunity to contest this Application. The proper resolution of this opposition requires that the Board consider the opposition fully rather than dismiss it on purely procedural grounds. Closing the opposition on a procedural ground denies the Opposer an opportunity to present important arguments to the Board as to why the Application should be denied.

Additionally, the Board is rightly concerned with the efficient administration of matters pending before it. In this instance, the dismissal of the opposition on purely procedural grounds does not advance administrative efficiency because the Board must address the same issues and arguments in three other closely-related applications to nearly identical trademarks. Pursuant to TBMP § 502.04, the Board may deny the Applicant's Motion to Dismiss on its merits. The Board can and should adjudicate all three oppositions together because the relevant trademarks are very similar and closely

connected. To resolve all the related oppositions in a unified and efficient way, the Board should grant the motion to reopen.

## IV. CONCLUSION

The Board should grant Opposer's Motion to Reopen Time because, not only does Opposer have standing, it can ultimately establish that the Application must be rejected. In the Response, Applicant concedes that, if the Board reopens time, it will suffer no prejudice, there will be no negative impact on the proceeding and Opposer acted (and continues to act) in good faith. Administrative efficiency and uniform application of the law require that Opposer not be denied an opportunity to challenge closely-related applications for nearly identical marks.

Please address all communications to John Arai Mitchell, Esq., Arai Mitchell pc, 453 South Spring Street, Suite 930, Los Angeles, California 90013.

Dated: 16 May 2007

Respectfully submitted,

ARAI MITCHELL pc

By: _____
John Arai Mitchell

Attorney for Opposer
BRANDSTORM INC.

## PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the county of Los Angeles, State of California. I am over the age of 18 and not a party to the within action. My business address is 453 South Spring Street, Suite 930, Los Angeles, California 90013.

On May 16, 2007, I served the foregoing document

REPLY BRIEF IN SUPPORT OF OPPOSER'S MOTION TO REOPEN TIME NO. 91174297

On the interested parties in this action, addressed as follows:

Heather L Buchta, Esq.
QUARLES & BRADY LLP
One Renaissance Square
Two North Central Avenue
Phoenix, Arizona 85004-2391

(x) By Mail. I am "readily familiar" with the firm's practice of collecting and processing correspondence for mailing. Under that practice, it would be deposited with the U.S. Postal Service on the same day with postage thereon fully prepaid at Los Angeles, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

( ) By Overnight Courier. I caused the above-referenced document(s) to be delivered to an overnight courier service (Federal Express), for delivery to the above address (es).

(x) By Facsimile. I cause the above-referenced documents to be transmitted to the noted addressee(s) at the fax number as stated. Attached to this declaration is a "Confirmation Report" confirming the status of transmission.

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on May 16, 2007, at Los Angeles, California.

Maki Buschman